

REMARKS

I. Introduction

In the Office Action of April 10, 2007, claims 20, 22-23, and 45-48 are rejected based on the combination of Finkel et al. U.S. Patent No. 4,702,378 ("*Finkel*") and Caveness U.S. Patent Appl. Publication No. 2003/0029740 ("*Caveness*"). In particular, each of these claims stands rejected under §103(a) as being unpatentable over *Finkel* in view of *Caveness*.

Applicant respectfully requests reconsideration of the claim rejections in view of the following remarks.

Sole independent claim 20 recites a method of packaging a single, unused diaper that includes the steps of (1) "disposing the single, unused diaper within a substantially air impermeable encasement, the diaper being the only diaper disposed within the encasement"; (2) "volumetrically reducing a size of the unused diaper to a size convenient for carriage and storage of the diaper"; and (3) "maintaining the volumetrically reduced size of the diaper with the encasement."

Furthermore, the step of "maintaining the volumetrically reduced size of the diaper with the encasement" includes the step of (4) "maintaining the volumetrically reduced size with a pressure differential acting upon the encasement," wherein (5) "the pressure differential acting upon the encasement is created by forming a vacuum within the encasement and then sealing the encasement."

In rejecting independent claim 20 under §103(a), the Office Action on page 3 cites *Finkel* as the primary reference for the disclosure of disposing a diaper within an encasement that is substantially air impermeable. The Office Action finds that "the difference between *Finkel* and claim 20 is the provision that the packaged diaper is sealed as claimed."

The Office Action then cites *Caveness* as the secondary reference for the disclosure of "a towel, which may ultimately function as a diaper, in an air sealed, or alternatively, vacuum-sealed compartment including an airtight seal as set forth on page 2, [0021]."

Based on the combination of these disclosures, the Office Action concludes that it would have been obvious to a person having ordinary skill in the art at the time of the invention ("the Ordinary Artisan") to modify the diaper kit of *Finkel* by vacuum-sealing the disposable diaper of *Finkel* in the pouch 40 of the container 10 of the diaper kit of *Finkel*. This alleged obvious modification is supported by the assertion that the Ordinary Artisan would be motivated to make this modification of *Finkel* in order to provide a more compact, sanitary and portable article as taught by *Caveness* on page 2, [0003]-[0007].

II. Applicant traverses the stated rejection of claim 20 under §103 because there is no reasonable basis for the asserted modification of *Finkel* in view of *Caveness* so as to arrive at the presently claimed method.

Applicant submits that the stated rejection is improper because the alleged motivation as set forth in the Office Action would not, in fact, lead the Ordinary Artisan to the recited method of claim 20. The alleged motivation is that the Ordinary Artisan would be motivated to make this modification of *Finkel* in order to provide a more compact, sanitary and portable article as taught by *Caveness*. The asserted error in this reasoning is that there is no showing that vacuum-sealing the disposable diaper would, in fact, result in the diaper kit of *Finkel* being more compact, sanitary and portable.

The disposable diaper 80 in *Finkel* is inserted into the large pouch 40 of the container 10, which pouch is formed as part of the container 10. *See Finkel*, col. 4, lines 4-6 and lines 18-20. *Finkel* discloses that the diaper is received in the large pouch 40 in a nominal configuration. In particular, *Finkel* reveals in FIGS. 1 and 4 that the container 10 has a length that is approximately twice the nominal width of the diaper and a width that is approximately equal to the nominal length of the diaper.

Finkel further teaches that the pouch 40 is dimensioned to receive and retain therein both a diaper that is soiled as well as the used diaper accessories, *see, e.g., Finkel*, col. 2, lines 33-35 ("The package includes a pouch that receives and retains the soiled diaper and used baby care products after the baby's bottom has been cleaned."). These accessories includes a package of baby powder, a packet of petroleum jelly, a pre-

moistened towel, a dry towel, and soap. *See* col. 3, lines 3-8; Fig. 4. Thus, *Finkel* discloses that a soiled disposable diaper 80 and used accessories are inserted into the large pouch 40 for resealing and disposal of the container. *See Finkel* col. 4, lines 20-22.

Importantly, *Finkel* fails to teach or suggest any benefit or desire to volumetrically reducing the pouch 40 or the disposable diaper 80 when packaged therein. *Finkel* merely discloses a disposable diaper that is arranged in a nominal configuration (i.e., a bifolded configuration) and that is inserted into the large pouch 40 of the container 10 as represented in FIG. 4.

Finkel further fails to disclose or teach that the pouch is substantially air impermeable, as alleged in the Office Action.

Applicant submits that the disclosure of *Caveness*, when applied to *Finkel*, fails to overcome these deficiencies in the disclosure of *Finkel* so as to arrive at the presently recited method of claim 1. Specifically, nothing in *Caveness* suggests any motivation or benefit to volumetrically reducing the pouch 40 or, in turn, the disposable diaper 80 in *Finkel*. Reduction of the size of the disposable diaper 80 would not provide any apparent benefit, especially as such reduction would not lead to a reduction in the large pouch 40 or to a reduction in the overall container 10. *Finkel* teaches that the large pouch 40 needs to be sized and dimensioned to receive a soiled disposable diaper together with the used diaper accessories. Any reduction in the large pouch 40 would be counterproductive

because it would inhibit the disclosed and taught use of the container 10 as receiving therein the soiled diaper and used baby care products.

Consequently, the modification of the diaper kit of *Finkel* to vacuum-seal the disposable diaper 80 in the pouch 40 would result in increased costs and complexity in manufacturing without any apparent, offsetting benefits. Applicant submits that, in view of this, the Ordinary Artisan simply would not make the asserted combination relied upon in the Office Action.

In the absence of motivation or teaching to make the necessary modifications of the diaper kit of *Finkel* so as to encompass the method of claim 20, Applicant submits that it would not be obvious to the Ordinary Artisan to combine the disclosures of *Finkel* and *Caveness* so as to arrive at the method of independent claim 20. Consequently, Applicant submits that the §103 rejection of claim 20 should be withdrawn.

III. Applicant further traverses the rejection of claim 1 under §103 because *Caveness* is nonanalogous art.

In setting forth the rejections, the Office Action fails to define the Ordinary Artisan. More importantly, the Office Action fails to present any showing that *Caveness* is even applicable art under §103 in rejecting the claims.

Due to these legal deficiencies, the Office Action has failed to establish a *prima facie* showing of obviousness of the method of claim 20, and Applicant respectfully request

withdrawal of the §103 rejections and further consideration of the present application. Moreover, Applicant submits that the §103 rejection of claim 20 should be withdrawn because *Caveness* is, in fact, nonanalogous art and, therefore, inapplicable in any §103 rejection of the method of claim 1.

First, the Office Action fails to set forth any definition of the Ordinary Artisan.

In contrast, Applicant has made of record before the Examiner in serial no. 10/906,828 convincing evidence that the Ordinary Artisan "would be a person who has had broad exposure to packaging of disposable diapers and feminine hygiene products and to the details of the manufacture, distribution, and marketing of disposable diapers and feminine hygiene products to the extent such that manufacture, distribution, and marketing relate to the packaging materials," and that the Ordinary Artisan would "have at least an associate degree of formal education in a technical field, such as chemistry, material science, or packaging."

This definition of the Ordinary Artisan was proffered in Applicant's response filed on January 23, 2006 in 10/906,828, and was supported with substantial evidence in a Rule 132 declaration from Mr. Richard Anderson, who has over thirty-five years in the packaging industry. *A copy of Mr. Anderson's declaration as found in 10/906,828 is submitted herewith and made of record in this application.* No objection or issue has ever been taken by the Office, and no evidence contradicting this definition of the Ordinary Artisan as defined by Applicant has ever been proffered.

Second, the Office Action fails to set forth any definition of the field of endeavors of the present inventor and *Caveness*.

In contrast, the field of endeavor of the inventor of the present invention has been defined. Specifically, the field of endeavor was defined to be "the packaging of disposable diapers and feminine hygiene products" (hereinafter the "Snell Field of Endeavor"). This definition was proffered on January 23, 2006 in 10/906,828 and supported with substantial evidence including the Rule 132 declaration from Mr. Richard Anderson. No objection or issue has ever been taken by the Office, and no evidence contradicting this definition of the Snell Field of Endeavor as defined by Applicant has ever been proffered.

In considering *Caveness*, it is clear that the field of endeavor of *Caveness* is not the same as the Snell Field of Endeavor. As explicitly defined in *Caveness*, the field of *Caveness* is "compact packaged towels and methods for constructing same." *Caveness* does not relate to the field of packaging of diapers or feminine hygiene products. In fact, *Caveness* fails to disclose, mention, or otherwise suggest a diaper. Because the Snell Field of Endeavor relates to packaging of diapers or feminine hygiene products, the fields of endeavor of *Caveness* and Snell clearly are different.

Nor has the Office Action presented any evidence, let alone evidence overcoming that made of record by Applicant, that tends to establish that *Caveness* is within the same field of endeavor as that of the present invention. Indeed, any unsupported supposition

that is designed to arrive at the conclusion that *Caveness* is within the field of endeavor is improper.

As clearly shown in the Rule 132 Declaration submitted herewith, the definition set forth by Mr. Anderson is based on over thirty-five years experience in the packaging industry and reveals a relationship that simply exists in the real world between the packaging of diapers and the packaging of feminine products, as recognized by the Ordinary Artisan. The packaging of textiles, such as towels, simply does not fall within the scope of this actual field of endeavor to which the packaging of diapers belongs. Unsupported supposition and theory cannot be substituted for the reality evidenced by the Rule 132 Declaration. Accordingly, *Caveness* is not within the same field of endeavor as the inventor of the present application.

Just as *Caveness* is not within the same field of endeavor, *Caveness* similarly is not reasonably pertinent to the particular problem with which the inventor of the present invention (i.e., Snell) was concerned.

Specifically, the problem addressed by Snell was the development of “a diaper and related accessory kit that consumes a relatively small amount of space while providing

substantially all of the materials necessary to change an individual's diaper." See Appl. Publ. US 2005/0131368 A2 ("Appl. Publ."), ¶ [0009].¹

In contrast, the problem identified and addressed in *Caveness* is that of towel maintenance, including the carrying and laundering of towels, wherein the towels are used at health clubs, spas, gyms, and the beach, as well as used while camping and traveling internationally. See para. [0002] through para. [0007]. As used in *Caveness*, the term "towel" means a liquid absorbing material and, optionally, may be premoistened with water, soap, or other solution. See para. [0023]. Moreover, there is no disclosure or suggestion of a diaper in *Caveness* let alone the packaging of a diaper.

As *Caveness* deals with the problems of towel maintenance and addresses the problem through the packaging of disposable towels, and as Snell deals with the problems of bulky diapers and diaper bags and addresses the problem through a diaper kit that consumes a relatively small amount of space while providing substantially all of the materials necessary to change an individual's diaper, Applicant submits that *Caveness* would not have been "reasonably pertinent to the particular problem with which [Snell]

¹ In support of the problem identified and addressed by Snell, Applicant proffers evidence in the form of Mr. Anderson's declaration that the Ordinary Artisan would understand that Snell addresses the broad problem of providing greater consumer convenience to consumers of disposable diapers. See ANDERSON DECL. ¶ 26. This evidence is based on the recognition in Snell that the carrying of diapers "on the go" by consumers is often inconvenient; that the carrying of a "diaper bag" containing disposable diapers and diaper accessories for diaper changes "on the go" by consumers is often inconvenient; and that the solution comprises the vacuum-packing a single, disposable diaper so that the diaper and diaper kit is pocket sized for carrying in a pocket of the consumer. See ANDERSON DECL. ¶ 27-29.

was concerned.” In other words, the Ordinary Artisan simply would not have looked to *Caveness* as an obvious choice for consideration in attempting to develop a more convenient diaper kit for carrying and use by consumers; logically *Caveness* would not have commended itself to the Ordinary Artisan in considering the problem addressed by Snell.

Furthermore, Applicant acknowledges that the solution presented by *Caveness* and the solution presented by Snell do exhibit a commonality, namely, the utilization of vacuum packing technology. However, Applicant emphasizes that the proper inquiry as to whether *Caveness* would have commended itself to the Ordinary Artisan’s attention, when considering Snell’s problem, does not focus on the commonality in the solution, but on the commonality in the identified problem. Looking to the commonality in the solution in this type of inquiry represents impermissible hindsight.

Because *Caveness* is neither in the same field of endeavor nor addresses the same problem as Snell, *Caveness* is nonanalogous art and inapplicable in any §103 rejection. Accordingly, Applicant submits that the rejection of each claim based, in part, on *Caveness* is improper and should be withdrawn.

IV. Closing

In view of the foregoing amendments and remarks, Applicant requests both the withdrawal of the rejections set forth in the Office Action of April 10, 2007 and further consideration of the present application by the Examiner.

Respectfully submitted,
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